UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,301	12/08/2003	Martin Sawicki	60001.0288US01	2182

27488   7590   02/01/2007
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EXAMINER
BOTTS, MICHAEL K

ART UNIT	PAPER NUMBER
2176	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

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<td rowspan="2">Office Action Summary</td>
<td>Application No.
10/730,301</td>
<td>Applicant(s)
SAWICKI ET AL.</td>
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<td>Examiner
Michael K. Botts</td>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

- A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 November 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-28</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-28</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>11/2/06</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This is a Final Office Action on the merits.   This action is responsive to the following communication: Amendment, which was filed on November 2, 2006.

2.   Claims 1-28 are currently pending in the case, with claims 1, 10, and 19 being the independent claims.

3.   The amendment to the specification of the status of pending parent priority applications is accepted. Accordingly, any objection on that ground is withdrawn with the reminder that such is a continuing requirement.

4.   The CD ROM filing of computer code and the amendment to the specification noting the filing has been received and is accepted. Accordingly, the objection is withdrawn.

5.   Claims 1, 4,5, 10, 13, 14, 19, 23, and 24 were objected to for the use of the non-standard term "ML." Applicants have appropriately amended the claims. Accordingly, the objection is withdrawn.   .

6.   Claim 19 was objected for a minor informality. Applicants have appropriately amended the claim. Accordingly, the objection is withdrawn.

7.   Claims 1-9 and 19-26 were rejected under 35 U.S.C. 101. Applicants have appropriately amended the claims to obviate the rejections. Accordingly, the rejections to those claims are withdrawn.

8.   Claims 1-28 are rejected.

The Specification

9.   Applicant is reminded of the continuing requirement to update the status

(pending, allowed, etc.) of all parent priority applications in the first line of the

specification, when appropriate, and the status of all citations of U.S. filed applications

in the specification should also be updated, when appropriate.

Information Disclosure Statement

10.   A signed and dated copy of applicant's IDS, which was filed on November 2,

2006, is attached to this Office Action.

Claims Rejections – 35 U.S.C. 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

11.   Claim 13 recites the limitation "third component." There is insufficient antecedent

basis for this limitation in the claim.

12.   In the interest of compact prosecution, the application is further examined against

the prior art, as stated below, upon the assumption that the applicants may overcome

the above stated rejection under 35 U.S.C. 112, second paragraph.

Claims Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13.   **Claims 1-26** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by

Altova Inc. & Altova GmbH, "XML Spy 4.0 Manual," copyright 1998-2001, published

September 9, 2001, pages 1-401, [hereinafter "XML Spy"].

Regarding **claims 1-9**:

Claims 1-9 incorporate substantially similar subject matter as claimed in claims

10-18 below, respectively, and are rejected along the same rationale.

Regarding **independent claim 10, as amended**, XML Spy teaches:

A method for handling electronic documents, comprising:

editing an electronic document comprising automatically generated

document properties;

prompting and receiving custom properties for the electronic document

from a user; and

> *encoding in an a markup language (ML) format the electronic document,*
>
> *the automatically generated document properties, and the custom properties*
>
> *received from the user.*

(See, XML Spy, pages 1-401, teaching editing electronic documents with automatically

generated properties, prompting and receiving custom properties for the electronic

document from a user, and encoding the electronic document in a markup language,

including the automatically generated document properties and the custom properties

received from the user. See more specifically, XML Spy, pages 1-17 teaching editing

and saving electronic documents in XML, a markup language, and see XML Spy, page

354 teaching prompting a user to edit an electronic document.)

Regarding **dependent claim 11**, XML Spy teaches:

> *The method of Claim 10, wherein the electronic document is a word-*
>
> *processor document.*

(See, XML Spy, pages 198-207, teaching that the electronic document may be a word-

processor document.)

Regarding **dependent claim 12**, XML Spy teaches:

> *The method of Claim 10, wherein the electronic document is a*
>
> *spreadsheet document.*

(See, XML Spy, pages 67 and 99, teaching that the electronic document may be a

spreadsheet.)

Regarding **dependent claim 13**, XML Spy teaches:

> *The method of Claim 10, further comprising generating backwards compatibility properties in response to a version number of the computer-executable component, and wherein the third component is further arranged to encode the backwards compatibility properties in an ML format.*

(See, XML Spy, pages 51-90 teaching versioning and backwards compatibility in a markup language format. See also, XML Spy, page 55, teaching document version identification.)

Regarding **dependent claim 14**, XML Spy teaches:

> *The method of Claim 13, further comprising generating application environment properties in response to an application environment of the computer-executable components, and wherein the third component is further arranged to encode the application environment properties in an ML format.*

(See, XML Spy, pages 51-90 teaching versioning and backwards compatibility in a markup language format.)

Regarding **dependent claim 15**, XML Spy teaches:

> *The method of Claim 10, wherein the automatically generated document properties comprise a LastAuthor element.*

(It is noted that the disclosure of the element "Last Author" states only that it is a

property setting that "can be saved inside the 'DocumentProperties' element container,"

and that the term "represents the last author of the document." See, disclosure, page 8,

lines 8-10.

　　　　See, XML Spy, page 132, teaching identification of the user, or author, in the

save functions.)

Regarding **dependent claim 16**, XML Spy teaches:

　　　　The method of Claim 10, wherein the custom properties comprise a

　　　　Married element of type Boolean.

(It is noted that the term "Married" occurs in the disclosure solely as an example of what

might be saved in a "custom property setting." See, disclosure, page 9, lines 26-28, and

figure 5. Accordingly, the designation "Married" is read as non-functional descriptive

material and not limiting of the claimed invention. Saving of a Boolean type property in

a custom property function is read as limiting.

　　　　See, XML Spy, pages 287-362, teaching forms editing and custom properties,

including Boolean value properties.)

Regarding **dependent claim 17**, XML Spy teaches:

　　　　The method of Claim 13, wherein the backwards compatibility properties

　　　　comprise a Justification element.

(See, XML Spy, pages 147, 198, and 204, teaching forward and backward generation of

XML document in structured formats.)

Regarding **dependent claim 18**, XML Spy teaches:

> *The method of Claim 14, wherein the application environment properties*
>
> *comprise a zoom element.*

(See, XML Spy, pages 136 and 191, teaching the zoom element.)

Regarding **independent claim 19**:

Claim 19 incorporates substantially similar subject matter as claimed in claim 1

and is rejected along the same rationale.

Regarding **dependent claim 20**, XML Spy teaches:

> *The system of claim 19, wherein the electronic document is stored in a*
>
> *proprietary format.*

(See, XML Spy, pages 380-388, teaching that XML Spy is a commercially licensed

product and therefore, by definition, proprietary.)

Regarding **dependent claims 21-26** :

Claims 21-26 incorporate substantially similar subject matter as claimed in claims 11-

16, respectively, and are rejected along the same rationale.

14.   It is noted that any citations to specific, pages, columns, lines, or figures in the

prior art references and any interpretation of the references should not be considered to

be limiting in any way. A reference is relevant for all it contains and may be relied upon

for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Allowable Subject Matter

15.   Independent claim 10 may be placed in an allowable condition upon the inclusion

of the limitations of claim 13, and the resolution of the lack of antecedent basis issue of

the "third component" limitation from claim 13. It is noted that allowability would depend

on the specific language of the combinations of the limitations of claims 10 and 13, and

therefore would be subject to further search and consideration.

Response to Arguments

        Applicants' arguments filed November 2, 2006 have been fully considered, but

they are not persuasive.

Regarding rejection of claim 10:

        Applicants argue that the reference "fails to teach or suggest automatically or

manually editing document properties." See, Amendment, pages 9-15.

        The Examiner disagrees.

        See, XML Spy, pages 160-161, teaching manually defining and editing

properties.

Regarding rejection of claim 13:

Applicants argue that the reference "fails to teach or suggest backwards compatibility properties in response to a version number of the computer-executable component, and wherein the third component is further arranged to encode the backwards compatibility properties in an ML format." See, Amendment, pages 11-12.

The Examiner disagrees.

See, XML Spy, pages 51-90 teaching versioning and backwards compatibility in a markup language format. See also, XML Spy, page 55, teaching document version identification.

Regarding rejection of claim 15:

Applicants argue that the reference "fails to teach or suggest the automatically generated document properties that comprise a LastAuthor element." See, Amendment, page 12.

The Examiner disagrees.

See, XML Spy, page 132, teaching identification of the user, or author, in the save functions.

Regarding rejection of claim 18:

Applicants argue that the reference "fails to teach the zoom element." See,

Amendment, pages 13-15.

The Examiner disagrees.

See, XML Spy, pages 136 and 191, teaching the zoom element in the "zoom in" and "zoom out" menu buttons.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday through Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb

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